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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/771,441	02/05/2004	Arman Gilbert Bourgoïn	WH 11 723US	3184

24962 7590 04/20/2007
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EXAMINER

SILBERMANN, JOANNE

ART UNIT PAPER NUMBER

3611

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/20/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/771,441	Applicant(s) BOURGOIN ET AL.	
	Examiner Joanne Silbermann	Art Unit 3611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 8, 9, 11-16 and 31-41 is/are pending in the application.
- 4a) Of the above claim(s) 11-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 8, 9, 31-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Claims 11-16 stand withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 19 August 2005.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1,4,5,8,31-37,40 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hicinbothem et al. in view of Law et al. and Cilento et al.
4. Hicinbothem et al. show (Figure 1) a file folder comprising front panel 210 (or 212) and back panel 212 (or 210), and labeling tab 270. Hicinbothem et al. do not teach placing a cellulose reinforcing film on the front and back panels. Law et al. teach (column 1 lines 6-64) placing a cellulose reinforcing film over a printed substrate including the cover of a book, for example (column 1 line 16). Cilento et al. teach an adhesive that allows moisture exchange through the substrate. In view of the teachings of Law et al. and Cilento et al. it would have been obvious to one of ordinary skill in the art to modify Hicinbothem et al. by attaching a cellulose reinforcing film to the front and back panels (the cover) of the folder since this would protect the folder from finger marking, scratching, scuffing and abrasion, as taught by Law et al. (column 3 lines 26-

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35) and placing the reinforcing film on the front and back panels would protect the entire outer surfaces of the folder in a better manner.

5. Regarding claim 4, Hicinbothem et al. show (Figure 1) printing on the surface of the folder which would be visible through the reinforcing film.

6. Regarding claim 8, it is considered to be within the level of ordinary skill in the art to vary the thickness of the paper stock and film as desired.

7. Regarding claims 33, 36 and 41, the reinforcing film taught by Law et al. is the same material used by Applicant so it inherently includes all of the same characteristics.

8. Regarding claims 31 and 35, the adhesive of Cilento et al. is considered to be water based in that it includes water-soluble material that absorbs moisture (column 1 lines 50 and column 2 lines 62-63).

9. Claims 2,3,38 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hicinbothem et al. in view of Law et al. and Cilento et al. as applied to claims 1 and 37 above and further in view of Bohlman.

10. Hicinbothem et al. (as modified by Law et al. and Cilento et al.) teach Applicant's basic inventive concept except for writing indicia on the reinforcing film. Bohlman shows (Figures 1-3) that it is well known to place indicia 7 on base layer 3 and cover both sides of the base layer with transparent sheets 67 and then write indicia on top of the transparent sheets. In view of the teachings of Bohlman, it would have been obvious to one of ordinary skill in the art to modify Hicinbothem (as previously modified) since this would allow additional information (identifying information, date information,

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instruction information, deadline information, etc.) to be easily added to and removed from the folder in an easier and faster manner. As discussed in Bohlman (column 4 lines 46-47) these indicia will be permanent if written in ink. Bohlman does not specifically describe UV curable ink. It would have been obvious to one of ordinary skill to utilize this particular ink since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

11. Claims 1,4,5,8,9,31-37,40 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hicinbothem et al. in view of Law et al. Cilento et al. and Horwitz or Kuhns et al.

12. Hicinbothem et al. teach (Figures 1-4) a file folder comprising front panel 210 (or 212) and back panel 212 (or 210) and labeling tab 270. Hicinbothem et al. do not teach placing a cellulose reinforcing film on the front and back panels, Law et al. teach (column 1 lines 6-64) the idea of placing a cellulose reinforcing film over a printed substrate. Cilento et al. teach a water-based adhesive. Horwitz teaches (Figures 1-3) the idea of placing reinforcing film 22, 24 over the outer and inner surfaces of the front and back panels. Kuhns et al. teach (Figures 1-10) placing reinforcing film 5, 7 over the outer surfaces of the front and back panels. In view of the teachings of Law et al. and Horwitz or Kuhns et al. it would have been obvious to one of ordinary skill to modify Hicinbothem et al. by attaching a cellulose reinforcing film to the front and back panels of the folder since this would protect the folder from finger marking, scratching, scuffing

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and abrasion as taught by Law et al. (column 3 lines 26-35) and placing the reinforcing film on the front and back panels would protect the entire outer surfaces of the folder in a better manner.

13. Regarding claim 4, Hicinbothem et al. show (Figure 1) printing on the surface of the folder which would be visible through the reinforcing film.

14. Regarding claim 8, it is considered within the ordinary skill in the art to vary the thickness of the paper stock and film as desired.

15. Regarding claims 33, 36 and 41, the reinforcing film taught by Law et al. is the same material used by Applicant so it inherently includes all of the same characteristics.

16. Claims 2,3,38 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hicinbothem et al. in view of Law et al. and Cilento et al. and Horwitz or Kuhns et al. as applied to claim 1 above, and further in view of Bohlman.

17. Hicinbothem et al. in view of Law et al. Cilento et al. and Horwitz of Kuhns et al. teach Applicant's basic inventive concept except for writing indicia on the reinforcing film. Bohlman (Figures 1-3) teaches that it is known to place indicia 7 on a base layer, 3, and cover both sides of the base layer with transparent sheets 67 and then write indicia on top of the transparent sheet. In view of the teachings of Bohlman it would have been obvious to one of ordinary skill in the art to modify Hicinbothem (as previously modified) since this would allow additional information (as described previously) to be easily added to and removed from the folder in an easier and faster manner.

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18. Bohlman teaches the use of permanent ink, as described previously.

Response to Arguments

19. Applicant's arguments filed 08 January 2007 have been fully considered but they are not persuasive.

20. Applicant argues that the references do not provide motivation for the proposed combinations, however there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. *In re McLaughlin*, 170 USPQ 209 (CCPA 1971). Law shows using a protective film for indicia. When combined with Hicinbothem, this would suggest protecting the indicia of Hicinbothem with a film. Law suggests using this on a book cover only as an example. Law also teaches covering the indicia, which when combined, would suggest covering the tab of Hicinbothem.

21. Similarly, the combination of Cilento would suggest using a film that absorbs moisture (such as perspiration) on the tab. Such indicia on index tabs are exposed to moisture every time the folder is used.

22. Regarding the ink, Bohlman teaches indicia that may be made permanent, as discussed above.

23. Regarding the recycling, any material that is reused is considered to be recycled. Additionally the use of color to identify file folders is old and well known.

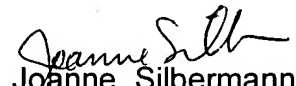
Conclusion

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joanne Silbermann whose telephone number is 571-272-6653. The examiner can normally be reached on M-F 5:30 - 2:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on 571-272-6651. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Joanne Silbermann
Primary Examiner
Art Unit 3611

js
15 April 2007